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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,340	12/13/2001	Shell S. Simpson	10008222-1	6165

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MURPHY, DILLON J

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/021,340

Applicant(s)

SIMPSON ET AL.

Examiner

Dillon J. Murphy

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2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

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Continuation of 11. does NOT place the application in condition for allowance because:

On page 7 of Remarks, Applicant summarizes the disclosure of Al-Hussein as teaching a "stand-alone 'personal imaging computer system'", wherein the personal imaging computer system (PICS) comprises a facsimile machine having the capabilities of a computer and is not described as performing the functions of a printer. By Applicant's own admission, on page 8-9 of Remarks, corresponding to Al-Hussein, col 5, ln 53-60, the "PICS equipment includes a general purpose computer...whereby an operator is able to...print out document images..." Returning to Al-Hussein at fig 3 and col 5, ln 38-32, element 26 is the printer section in the PICS equipment operable to "print out document images." It seems that Applicant is finding fault in the PICS of Al-Hussein because the equipment 20 comprises a CPU #60, RAM Memory #79, and ROM #77, (which define a computer), in addition to the printer section #26. However, it is clear from fig 3 of the instant application that the addition of a processing device and memory does not make Applicant's Hard Copy Generation Hardware #304 any less of a printer. Just as the printing device #204 inherits the functionality of the Hard Copy Generation Hardware #304 in the Applicant's invention, the PICS #20 inherits the functionality of the printer section #26 as disclosed in Al-Hussein.

On pages 8-11, Applicant argues that the PICS equipment #20 is merely a facsimile machine with a general purpose computer. It follows, in the Applicant's argument, that because the PICS is not a printer, the actions performed by the PICS such as accessing and retrieving imaging data from a network store are not performed by a printer as is required by independent claim 11. As was recited in the Office Action

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mailed November 17, 2006, Al-Hussein discloses accessing files via a network disk in col 6, ln 12-16, and retrieving files at col 6, ln 22-25. In these examples teaching accessing and retrieving files, the PICS equipment was connected to a network to provide its capabilities to the computerized network users (Al-Hussein, col 6, ln 2-4). Thus, in the system of Al-Hussein, computing devices are capable of accessing and retrieving data via a network. The PICS, as previously mentioned, comprises a general purpose computer as a single stand-alone device that contains document scanning, storage, and processing equipment which is connectable to a computerized local area network (Al-Hussein, col 5, ln 6-10). Based upon the facts presented above that (i) the PICS provides the accessing and retrieving capabilities to the computer #40 when connected to a network and (ii) the PICS may operate as a stand alone device, it is clear that the PICS is capable of performing the very actions the device provides to other network computing devices as a stand alone unit, namely accessing and retrieving data for printing. Upon connecting the PICS to the network, the PICS is able to access and retrieve data via a network store (Al-Hussein, col 8, ln 63-col 9, ln 8) as recited in claim 1.

On page 11, Applicant objects to the rejection as unclear by alleging the Office Action refers to both "Al-Hussein's 'printers 45' and to 'PICS equipment 20' in alleging that Al-Hussein teaches a 'printer' that performs the various actions recited in claim 11. The examiner clearly states in the Office Action and above that the PICS equipment 20 itself comprises printer #26 and therefore the PICS reads on a printer. No attempt is made to combine printer #45 and PICS #20 of Al-Hussein.

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On page 12, Applicant argues that there is not suggestion, teaching, or motivation to combine the references Al-Hussein and Lo. The examiner respectfully disagrees, citing Lo in col 5, ln 31-35, wherein Lo teaches a utility stored in the printer to facilitate file downloading and file management procedures. Thus Lo provides motivation to combine the printer-based form overlay method, system, and apparatus with the network accessing and retrieving method, system and apparatus of Al-Hussein.

On page 13, Applicant argues independent claims 19 and 24 are allowable for reason pointed out above for claim 11. Thus, similar arguments as applied above to claim 11 apply to claims 19 and 24.

Diller M
January 25, 2007

Aung Moe
AUNG MOE
PRIMARY EXAMINER